

AMENDMENT UNDER 37 C.F.R. § 1.111
Application No. 10/579,341 (Attorney Docket No. Q92644)

REMARKS

Status of the Claims

In the present Amendment, Claim 1 is amended to define the crosslinkable X group of formula (I). Support is found, for example, at page 5, lines 6-16 of the specification.

Claims 2 and 3 have been canceled.

No new matter has been added, and entry of the Amendment is respectfully requested.

Upon entry of the Amendment, Claims 1, 4 and 6-16 will be pending, of which claims 10-16 are withdrawn from consideration.

Allowable Subject Matter

On page 2 of the Office Action, the Examiner objects to Claims 4, 6 and 7 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants thank the Examiner for indicating that Claims 4, 6 and 7 contain allowable subject matter.

The Examiner's Written Description Rejection is Moot

On page 3 of the Office Action, the Examiner rejects Claim 3 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Without conceding to the merits of the rejection, Claim 3 has been canceled herein. The written description rejection of Claim 3 is thus moot.

In view of the above, withdrawal of the rejection of Claim 3 under 35 U.S.C. § 112, first paragraph is requested.

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The Claimed Aryl Amine Compound is Clear, Definite and Unambiguous

On page 5 of the Office Action, Claims 1-3, 8 and 9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

According to the Examiner, Claims 1-3, 8 and 9 are indefinite for because of the definition of the constituent X in formula (I).

The Examiner cites to the examination guidelines on 35 U.S.C. § 112, second paragraph, dated February 9, 2011. The Examiner quotes a section of the guidelines stating that “a Markush group that encompasses a massive number of distinct alternative species may be indefinite under § 112, ¶2 if one skilled in the art cannot determine the metes and bounds of the claim due to an inability to envision all of the members of the Markush group” (Fed. Reg., Vol. 76, No. 27, at page 7166). The Examiner also cites the section of the examination guidelines stating that a Markush group may be improper if all the species within the group do not share a single structural similarity or common use.

Applicants traverse and respectfully request the Examiner to reconsider and withdraw the rejection in view of the amendment to Claim 1 and the following remarks.

The Examiner does not provide a specific analysis pointing out why one of ordinary skill in the art would not be able to determine the metes and bounds of Claim 1. Thus, the Examiner did not meet his burden for establishing indefiniteness.

The Examiner’s primary concern appears to be the recitation “crosslinkable group,” indicating that a large number of compounds fall within the scope of crosslinkable group. However, the same examination guidelines cited by the Examiner state that “A Markush claim may encompass a large number of alternative specifics, but is not necessarily indefinite under § 112, ¶2 for such breadth.” In other words, Claim 1 is not indefinite for being broad.

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In addition, the term crosslinkable group has a well-known meaning in the art, and thus, the scope of the term would be understood by persons of skill in the art. Further, the elements of the group would all share the same structural similarity of being a crosslinkable group.

Also, without conceding to the merits of the rejection, Claim 1 has been amended herein such that the recitation “a cross-linkable group” is directed to concrete and specific groups from the specification that clearly share the same structural similarity of being “cross-linkable.”

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 112, second paragraph.

The Claimed Arylamine Compound is Patentable over Woo

On page 8 of the Office Action, Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) as being anticipated by Woo et al. (U.S. Patent 5,929,194) (“Woo”).

Applicants respectfully traverse.

The Examiner’s rejection in the present Office Action is not entirely clear. The Examiner appears to be taking the position that the compound in Example 11 of Woo, N,N-di-(4-bromophenyl)-p-tolylamine, anticipates Claims 1 and 2 when n=1, n’=0, Z=bromo and X=toluencyl group. In this regard, the Examiner takes the position that the toluencyl group is “capable” of forming a double bond.

However, the substituent X in amended Claim 1 excludes a toluencyl group. Accordingly, Example 11 of Woo does not disclose or suggest the claimed arylamine compound.

The Examiner also states that the “compound of Example 12 have boronic acid groups have Z=-B(OR₁)₂ wherein R₁=H.” The Examiner did not make it clear why hrefers to Example 12 of Woo.

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However, the compound N,N-di-(4-benzeneboronic acid)-p-tolylamine disclosed in Example 12 cannot disclose the claimed arylamine compound because the substituent X in formula (I) does not encompass a toluenyl group.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1 and 2 as being anticipated by Woo

Conclusion

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The U.S. Patent and Trademark Office is hereby directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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